

**CERTIFICATE OF MAILING**

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to the: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Burton Rodney  
Type or print name

Signature

April 28, 2005  
Date

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

IN RE APPLICATION OF

Art Unit: 1614

BETH ANNE PIPER

Examiner: R. Cook

APPLICATION NO: 09/460,920

FILED: DECEMBER 14, 1999

FOR: METHOD FOR TREATING DIABETES

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**LETTER**

Sir:

On November 16, 2004 Applicants submitted a "Petition to Revive Abandoned Application Under 37 C.F.R. 1.137(b)" to revive the subject application which was abandoned unintentionally through failure to comply with 37 C.F.R. 1.114 by filing an improper RCE.

On April 15, 2005, a decision to dismiss the above petition was issued (copy attached). The petition was dismissed for failure to include payment of the issue fee and publication fee in the subject application.

On April 25, 2005, the undersigned attorney discussed the petition with Edward J. Tannouse who dismissed the petition. Mr. Tannouse indicated that the petition should be resubmitted with the issue fee and publication fee.

Attached is the Petition as originally submitted. In addition, authorization to charge Deposit Account No. 19-3880 for the issue fee and publication fee for a total of \$1,600 is enclosed herewith.

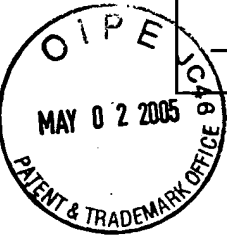
05/05/2005 AWONDAF2 00000009 193880 09460920

01 FC:1501 1400.00 DA  
02 FC:1504 300.00 DA



**23914**

PATENT TRADEMARK OFFICE



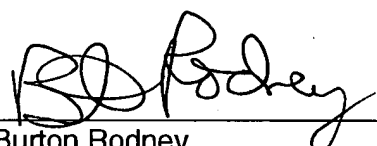
It is submitted that inasmuch as the petition fee of \$1,370 was already charged to Applicants' Deposit Account No. 19-3880, the petition fee need not be paid again.

Please note that although Applicants have authorized payment of the issue fee, the subject application should not be allowed to issue and that the application should be abandoned in favor of the RCE previously submitted and which is now in compliance with the 37 C.F.R. 1.114.

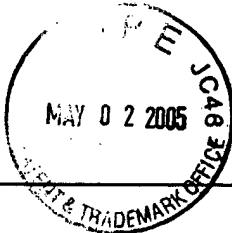
In view of the above, it is respectfully requested that a favorable decision on the instant petition be granted.

Respectfully submitted,

Bristol-Myers Squibb Company  
Patent Department  
P.O. Box 4000  
Princeton, NJ 08543-4000  
(609) 252-4336

  
\_\_\_\_\_  
Burton Rodney  
Attorney for Applicants  
Reg. No. 22,076

Date: April 28, 2005

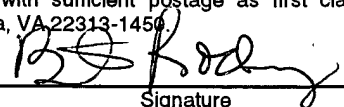


CASE LA0046a CIP-1

**CERTIFICATE OF MAILING**

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Burton Rodney  
Type or print name

  
Signature

April 28, 2005  
Date

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

IN RE APPLICATION OF

Art Unit: 1614

BETH ANNE PIPER

Examiner: R. Cook

APPLICATION NO: 09/460,920

FILED: DECEMBER 14, 1999

FOR: METHOD FOR TREATING DIABETES

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

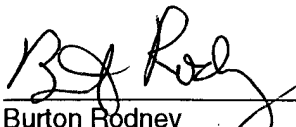
**AUTHORIZATION TO CHARGE DEPOSIT ACCOUNT NO. 19-3880  
FOR ISSUE FEE AND PUBLICATION FEE**

Sir:

Please charge Deposit Account No. 19-3880 in the name of Bristol-Myers Squibb Company in the amount of \$1600 for payment of the issue fee and publication fee. An additional copy of this paper is here enclosed. The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment, to Account No. 19-3880 in the name of Bristol-Myers Squibb Company.

Respectfully submitted,

Bristol-Myers Squibb Company  
Patent Department  
P.O. Box 4000  
Princeton, NJ 08543-4000  
(609) 252-4336  
Date: April 28, 2005

  
Burton Rodney  
Attorney for Applicant  
Reg. No. 22,076



23914

PATENT TRADEMARK OFFICE



UNITED STATES PATENT AND TRADEMARK OFFICE



**RECEIVED**  
**BMS PATENT LAW**

APR 18 2005

STEPHEN B. DAVIS  
BRISTOL-MYERS SQUIBB COMPANY  
PATENT DEPARTMENT  
P.O. BOX 4000  
PRINCETON, NJ 08543-4000

Docketed Item

Due Date

Attorney

OA

6/15/05

Rodney

COPY MAILED

APR 15 2005

OFFICE OF PETITIONS

In re Application of  
Beth Anne Piper  
Application No. 09/460,920  
Filed: December 14, 1999  
Attorney Docket No. LA0046A

:  
:  
:  
:  
:

ON PETITION

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed November 18, 2004, to revive the above-identified application.

The petition is **dismissed**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)."

This application became abandoned for failure to timely pay the issue fee and publication fee, if applicable, on or before May 12, 2003. Accordingly, this application became abandoned on May 13, 2003.

Effective December 1, 1997, the provisions of 37 CFR 1.137(b) now provide that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application pursuant to 37 CFR 1.137(b). A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by:

- (1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application, abandoned or lapsed for failure to pay

2

LA0046A  
US-CPA  
Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
www.uspto.gov

the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

(2) the petition fee as set forth in 37 CFR 1.17(m);

(3) a statement that the **entire** delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and

(4) any terminal disclaimer (and fee set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(d).

The instant petition does not satisfy requirement (1) above.

Please note MPEP 706.07(h):

A. Treatment of Improper RCE

If one or more conditions for filing an RCE have not been satisfied, applicant will be so notified. Generally, a "Notice of Improper Request for Continued Examination (RCE)," Form PTO-2051, will be mailed to applicant. An improper RCE will not operate to toll the running of any time period set in the previous Office action for reply to avoid abandonment of the application. (Emphasis added).

As such, the \$1400.00 issue fee and \$300.00 publication must be submitted in order to revive the above-identified application. Neither fee has been submitted, nor is an authorization to change said fees found with the instant petition.

Accordingly, the petition must be dismissed.

Further correspondence with respect to this matter should be addressed as follows:

By mail:           Mail Stop Petition  
                    Commissioner for Patents  
                    Box 1450  
                    Alexandria, VA 22313

By FAX: (703) 872-9306  
Attn: Office of Petitions

By hand: Customer Service Window  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

Telephone inquiries should be directed to the undersigned at  
(571)272-3228.



Edward J. Tannouse  
Petitions Attorney  
Office of Petitions/Patent  
United States Patent and Trademark Office



CASE LA0046a CIP-1

CERTIFICATE OF MAILING

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to the: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Burton Rodney  
Type or print name

*Burton Rodney*  
Signature

November 16, 2004  
Date

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF

Art Unit: 1614

BETH ANNE PIPER

Examiner: R. Cook

APPLICATION NO: 09/460,920

FILED: DECEMBER 14, 1999

FOR: METHOD FOR TREATING DIABETES

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

PETITION TO REVIVE

ABANDONED APPLICATION UNDER 37 C.F.R. 1.137(b)

Sir:

Petitioner, Bristol-Myers Squibb Company, owner of the subject application via an Assignment recorded on December 14, 1999 on Reel 010463 and Frame 0160, respectfully petitions the Commissioner to revive the subject application which was abandoned unintentionally through failure to comply with 37 C.F.R. 1.114 by filing an improper Request for Continued Examination (RCE) under 37 C.F.R. 1.114.

Under 37 C.F.R. 1.114 a request for continued examination of the application must be accompanied by a submission and the fee set forth in §1.17(e)(2) prior to abandonment of the application. The submission may be an information disclosure statement.

In fact, after a Notice of Allowance mailed February 11, 2003 (Exhibit A) was received in the subject application, instead of paying the issue fee by the May 11, 2003 due date, Applicant filed a Request for Continued Examination (RCE) on May 9, 2003, a copy of which is attached (Exhibit B). However, Applicant failed to file the required Submission under 37 C.F.R. 1.114 with the Request.

It was not until May 28, 2004 that Applicant filed a Supplemental Information Disclosure Statement (copy enclosed, Exhibit C) which would have qualified as a Submission if filed before the subject application was abandoned. On August 30, 2004, Applicant filed yet a second Supplemental Information Disclosure Statement (copy enclosed, Exhibit D).

On October 4, 2004, Applicant received a "Notice of Improper Request For Continued Examination (RCE)", copy of which is attached (Exhibit E) wherein in paragraph 7 thereof it is indicated that the request was not accompanied by the required submission, as signed by Ms. F. Patterson. It was not until receipt of this "Notice" that Applicant's attorney was aware that the RCE filed on May 4, 2003 was improper.

In the past month, the undersigned attorney of record has been in contact with Examiner Rebecca Cook, Ms. F. Patterson, Ms. Brenda Gray, Ms. Margaret Stevens and Ms. Rene Jones of the U.S. Patent and Trademark Office in an effort to determine what had to be done to correct the deficiency in the RCE and/or otherwise revive the subject application.

On November 1, 2004, the undersigned attorney spoke with Ms. Margaret Stevens who informed him that the application would have to be revived.

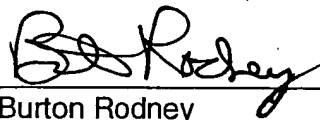
- (1) This Petition will serve as a reply to the "Notice".
- (2) The Commissioner is hereby authorized to charge Deposit Account No. 19-3880 in the name of Bristol-Myers Squibb Company in the amount of \$1,370.00, the petition fee as set forth in §1.117(m) for filing a petition for the revival of an unintentionally abandoned application.
- (3) The entire delay in filing the required submission with the RCE from the due date for the reply (August 12, 2003 - the due date for filing the issue fee based on the May 12, 2003 Notice of Allowance or for filing an RCE) until the filing of the present Petition was unintentional. As indicated, Applicants' attorney was unaware of the deficiency in the RCE filed on May 9, 2003 until received the Notice on October 4, 2004.



In view of the above, it is respectfully requested that this petition to revive this application be granted and that the RCE be reinstated. The required Submission has been previously filed on May 28, 2004, with the filing of a Supplemental Information Disclosure Statement.

Respectfully submitted,

Bristol-Myers Squibb Company  
Patent Department  
P.O. Box 4000  
Princeton, NJ 08543-4000  
(609) 252-4336

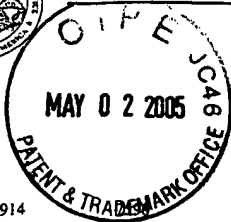
A handwritten signature in black ink, appearing to read "Burton Rodney", is written over a horizontal line.

Burton Rodney  
Attorney for Applicant  
Reg. No. 22,076

Date: November 16, 2004



## UNITED STATES PATENT AND TRADEMARK OFFICE



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UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

BMS PATENT LAW

## NOTICE OF ALLOWANCE AND FEE(S) DUE

023914

02/11/2003

FEB 18 2003

STEPHEN B. DAVIS  
BRISTOL-MYERS SQUIBB COMPANY  
PATENT DEPARTMENT  
P O BOX 4000  
PRINCETON, NJ 08543-4000

Docketed Item

Due Date

Attorney

EXAMINER

COOK, REBECCA

ART UNIT

CLASS-SUBCLASS

1614

514-593000

DATE MAILED: 02/11/2003

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/460,920	12/14/1999	BETH ANNE PIPER	LA0046A	3115

TITLE OF INVENTION: METHOD FOR TREATING DIABETES

APPLN. TYPE	SMALL ENTITY	ISSUE FEE	PUBLICATION FEE	TOTAL FEE(S) DUE	DATE DUE
nonprovisional	NO	\$1300	\$300	\$1600	05/12/2003

THE APPLICATION IDENTIFIED ABOVE HAS BEEN EXAMINED AND IS ALLOWED FOR ISSUANCE AS A PATENT. **PROSECUTION ON THE MERITS IS CLOSED.** THIS NOTICE OF ALLOWANCE IS NOT A GRANT OF PATENT RIGHTS. THIS APPLICATION IS SUBJECT TO WITHDRAWAL FROM ISSUE AT THE INITIATIVE OF THE OFFICE OR UPON PETITION BY THE APPLICANT. SEE 37 CFR 1.313 AND MPEP 1308.

THE ISSUE FEE AND PUBLICATION FEE (IF REQUIRED) MUST BE PAID WITHIN THREE MONTHS FROM THE MAILING DATE OF THIS NOTICE OR THIS APPLICATION SHALL BE REGARDED AS ABANDONED. **THIS STATUTORY PERIOD CANNOT BE EXTENDED.** SEE 35 U.S.C. 151. THE ISSUE FEE DUE INDICATED ABOVE REFLECTS A CREDIT FOR ANY PREVIOUSLY PAID ISSUE FEE APPLIED IN THIS APPLICATION. THE PTOL-85B (OR AN EQUIVALENT) MUST BE RETURNED WITHIN THIS PERIOD EVEN IF NO FEE IS DUE OR THE APPLICATION WILL BE REGARDED AS ABANDONED.

## HOW TO REPLY TO THIS NOTICE:

## I. Review the SMALL ENTITY status shown above.

If the SMALL ENTITY is shown as YES, verify your current SMALL ENTITY status:

A. If the status is the same, pay the TOTAL FEE(S) DUE shown above.

B. If the status is changed, pay the PUBLICATION FEE (if required) and twice the amount of the ISSUE FEE shown above and notify the United States Patent and Trademark Office of the change in status, or

If the SMALL ENTITY is shown as NO:

A. Pay TOTAL FEE(S) DUE shown above, or

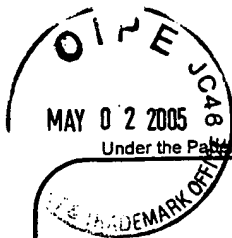
B. If applicant claimed SMALL ENTITY status before, or is now claiming SMALL ENTITY status, check the box below and enclose the PUBLICATION FEE and 1/2 the ISSUE FEE shown above.

☐ Applicant claims SMALL ENTITY status.  
See 37 CFR 1.27.

II. PART B - FEE(S) TRANSMITTAL should be completed and returned to the United States Patent and Trademark Office (USPTO) with your ISSUE FEE and PUBLICATION FEE (if required). Even if the fee(s) have already been paid, Part B - Fee(s) Transmittal should be completed and returned. If you are charging the fee(s) to your deposit account, section "4b" of Part B - Fee(s) Transmittal should be completed and an extra copy of the form should be submitted.

III. All communications regarding this application must give the application number. Please direct all communications prior to issuance to Box ISSUE FEE unless advised to the contrary.

**IMPORTANT REMINDER:** Utility patents issuing on applications filed on or after Dec. 12, 1980 may require payment of maintenance fees. It is patentee's responsibility to ensure timely payment of maintenance fees when due.



Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

**Request  
For  
Continued Examination (RCE)  
Transmittal**Address to:  
Commissioner for Patents  
Box RCE  
Washington, DC 20231

Application Number	09/460,920
Filing Date	December 14, 1999
First Named Inventor	Piper
Art Unit	1614
Examiner Name	R. Cook
Attorney Docket Number	LA0046a CIP-1

This is a Request for Continued Examination (RCE) under 37 CFR 1.114 of the above-identified application. Request for Continued Examination (RCE) practice under 37 CFR 1.114 does not apply to any utility or plant application filed prior to June 8, 1995, or to any design application. See Instruction Sheet for RCEs (not to be submitted to the USPTO) on page 2.

**1. Submission required under 37 CFR 1.114**

- a. ☐ Previously submitted
- i. ☐ Consider the amendment(s)/reply under 37 CFR 1.116 previously filed on \_\_\_\_\_  
(Any unentered amendment(s) referred to above will be entered).
- ii. ☐ Consider the arguments in the Appeal Brief or Rely Brief previously filed on \_\_\_\_\_
- iii. ☐ Other \_\_\_\_\_
- b. ☐ Enclosed
- i. ☐ Amendment/Reply
- ii. ☐ Affidavit(s)/ Declaration(s)
- iii. ☐ Information Disclosure Statement (IDS)
- iv. ☐ Other \_\_\_\_\_

**2. Miscellaneous**

- a. ☐ Suspension of action on the above-identified application is requested under 37 CFR 1.103(c) for a period of \_\_\_\_\_ months. (Period of suspension shall not exceed 3 months; Fee under 37 CFR 1.17(i) required)
- b. ☐ Other \_\_\_\_\_

**3. Fees**

- The RCE fee under 37 CFR 1.17(e) is required by 37 CFR 1.114 when the RCE is filed.
- The Director is hereby authorized to charge the following fees, or credit any overpayments, to
- a. ☒ Deposit Account No. 19-3880
- i. ☒ RCE fee required under 37 CFR 1.17(e) - \$750.00
- ii. ☐ Extension of time fee (37 CFR 1.136 and 1.17)
- iii. ☐ Other \_\_\_\_\_
- b. ☐ Check in the amount of \$ \_\_\_\_\_ enclosed
- c. ☐ Payment by credit card (Form PTO-2038 enclosed)

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

**SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT REQUIRED**

Name (Print/Type)	Burton Rodney	Registration No. (Attorney/Agent)	22,076
Signature	<i>Burton Rodney</i>	Date	May 8, 2003

**CERTIFICATE OF MAILING OR TRANSMISSION**

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner For Patents, Box RCE, Washington, DC 20231, or facsimile transmitted to the U.S. Patent and Trademark Office on the date shown below.

Name (Print/Type)	Burton Rodney	Date	May 9, 2003
Signature	<i>Burton Rodney</i>		

Page 1 of 2

This collection of information is required by 37 CFR 1.114. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, Box RCE, Washington, DC 20231.

If you need assistance in completing the form, call 1-800-PTO-9199 (1-800-786-9199) and select option 2.

**EXHIBIT B**

**CERTIFICATE OF MAILING**

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to the: Assistant Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22202.

Kathleen Bodine  
Type or print name

*Kathleen Bodine*  
Signature

May 28, 2004  
Date

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF

BETH ANNE PIPER

APPLICATION NO: 09/460,920

FILED: DECEMBER 14, 1999

FOR: METHOD FOR TREATING DIABETES

Art Unit: 1614

Examiner: R. Cook

Mail Stop Box Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT**

Sir:

In accordance with 37 C.F.R. §1.56, applicant wishes to call the Examiner's attention to the references cited on the attached form(s) PTO-1449.

The reference was cited in a search report in a corresponding Georgian application. A copy of the reference and the search report are enclosed herewith.

A petition pursuant to 37 C.F.R. §1.97(d) is enclosed herewith.

The Examiner is requested to consider the foregoing information in relation to this application and indicate that each reference was considered by returning a copy of the initialed PTO 1449 form(s).

EXHIBIT C



Certificate under 37 C.F.R. §1.97(e)(1)

I, the undersigned attorney, hereby certify that each item of information contained in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this Statement.

Respectfully submitted,

Burton Rodney  
Attorney for Applicant  
Reg. No. 22,076

Bristol-Myers Squibb Company  
Patent Department  
P.O. Box 4000  
Princeton, NJ 08543-4000  
(609) 252-4336

Date: May 28, 2004

**CERTIFICATE OF MAILING**

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Kathleen Bodine  
Type or print name

*Kathleen Bodine*  
Signature

May 28, 2004  
Date

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

IN RE APPLICATION OF

Art Unit: 1614

BETH ANNE PIPER

Examiner: R. Cook

APPLICATION NO: 09/460,920

FILED: DECEMBER 14, 1999

FOR: METHOD FOR TREATING DIABETES

Mail Stop Box Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**PETITION PURSUANT TO 37 CFR §1.97(d)**

Sir:

Consideration of the Supplemental Information Disclosure Statement submitted concurrently herewith is requested. Please charge Deposit Account No. 19-3880 in the name of Bristol-Myers Squibb Company in the amount of \$130 for payment of the fee for filing this petition.

An additional copy of this paper is here enclosed. The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment, to Account No. 19-3880 in the name of Bristol-Myers Squibb Company.

Respectfully submitted,

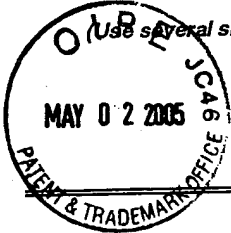
Bristol-Myers Squibb Company  
Patent Department  
P.O. Box 4000  
Princeton, NJ 08543-4000  
(609) 252-4336  
Date: 5-28-04

*Burton Rodney*  
Burton Rodney  
Attorney for Applicant  
Reg. No. 22,076

**INFORMATION DISCLOSURE CITATION**

ATTY. DOCKET NO.  
LA0046a CIP-1  
APPLICATION NO.  
09/460,920  
APPLICANT  
Beth Anne Piper  
FILING DATE  
DECEMBER 14, 1999

Group  
1614



**U.S. PATENT DOCUMENTS**

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUBCLASS	FILING DATE
	AA						
	AB						
	AC						
	AD						
	AE						
	AF						
	AG						
	AH						
	AI						
	AJ						
	AK						
	AL						

**FOREIGN PATENT DOCUMENTS**

		DOCUMENT NUMBER	DATE	OFFICE	CLASS	SUBCLASS	TRANSLATION	
							YES	NO
	AM						<input type="checkbox"/>	<input type="checkbox"/>
	AN						<input type="checkbox"/>	<input type="checkbox"/>
	AO						<input type="checkbox"/>	<input type="checkbox"/>
	AP						<input type="checkbox"/>	<input type="checkbox"/>
	AQ						<input type="checkbox"/>	<input type="checkbox"/>

**OTHER DOCUMENTS** (Including Author, Title, Date, Pertinent pages, Etc.)

	AR	Lemaire, V., "La metformine doit-ell etre associee a un sulfamide ou utilisee seule?", Concours med., 1996, 7, p. 436-437.
	AS	
	AT	

EXAMINER

DATE CONSIDERED

\*EXAMINER: Initial of reference considered, whether or not citation is in conformance with MPEP 609: Draw a line through citation if not in conformance and not considered. Include a copy of this form with the next communication to applicant.

Form 7-g

## SEARCH REPORT

Application filing No. 3877/01-02  
Demand No. 24763

Application No. AP 2000.004798

I. Parent Classification	
Classification System IPC (7)	Classification Symbols A61K 31/64, A61P 3/10
II. Fields Searched	
Sources to considered information	
Classification System IPC	Classification Symbols A61K, A61P
III. Documentation Considered to be Relevant	
Category	Citation of document with indication, were appropriate, of the relevant passages
Y	WO 9929314 (SQUIB BRISTOL MYERS CO) 17.06.1999
Y	Lemaire V.; La metformine doit-elle etre associee a un sulfamide ou utilisee seule.; Concours med., 1996, 7, p.436-437
Y	US 5922769 (BARELEI GIULIO et al.) 13.07.1999
Special categories of cited documents:	
"A" document defining the general state of the art	
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"L" document which may throw doubts on priority claim(s)	
"O" document referring to an oral disclosure, use, exhibition or other means	
"C" document of particular relevance; the claimed invention cannot be considered to involve an inventive step when the document is combined with one or more other such documents, such combination being obvious to a person skilled in the art	
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"P" document published prior to the international filing date but later than the priority date claimed	
"X" document of particular relevance; the claimed invention cannot be considered novel	
& document patent analog	
IV. Certification	
Searching Authority "SAKPALENTI"	Date of Mailing of this Search Report 15.03.2004
Date of the Completion of the Search 15.03.2004	Signature of Authorized Officer D. Jobashvili

[ ], see attachment

Head of Department

D. Gogoladze



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I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to the: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

Burton Rodney  
Type or print name

*Burton Rodney*  
Signature

August 30, 2004  
Date

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF

BETH ANNE PIPER

Art Unit: 1614

Examiner: R. Cook

APPLICATION NO: 09/460,920

FILED: DECEMBER 14, 1999

FOR: METHOD FOR TREATING DIABETES

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT

Sir:

In accordance with 37 C.F.R. §1.56, applicant wishes to call the Examiner's attention to the reference cited on the attached form PTO-1449.

This reference was cited in a search report in a corresponding Australian application. A copy of this reference and the search report are enclosed herewith.

The Examiner is requested to consider the foregoing information in relation to this application and indicate that each reference was considered by returning a copy of the initialed PTO 1449 form(s).

EXHIBIT 1



23914

PATENT TRADEMARK OFFICE

Certificate under 37 C.F.R. §1.97(e)(1)

I, the undersigned attorney, hereby certify that each item of information contained in this Information Disclosure Statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this Statement.



Bristol-Myers Squibb Company  
Patent Department  
P.O. Box 4000  
Princeton, NJ 08543-4000  
(609) 252-4336

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Burton Rodney', written over a horizontal line.

Burton Rodney  
Attorney for Applicant  
Reg. No. 22,076

Date: August 30, 2004

CERTIFICATE OF MAILING

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to the: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

Burton Rodney  
Type or print name

Signature

August 30, 2004  
Date

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Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

PETITION PURSUANT TO 37 CFR §1.97(d)

Sir:

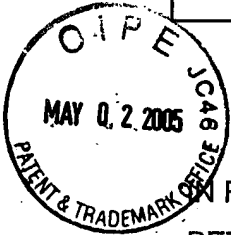
Consideration of the Information Disclosure Statement submitted concurrently herewith is requested. Please charge Deposit Account No. 19-3880 in the name of Bristol-Myers Squibb Company in the amount of \$180 for payment of the fee for filing this petition.

An additional copy of this paper is here enclosed. The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment, to Account No. 19-3880 in the name of Bristol-Myers Squibb Company.

Respectfully submitted,

Bristol-Myers Squibb Company  
Patent Department  
P.O. Box 4000  
Princeton, NJ 08543-4000  
(609) 252-4336  
Date: August 30, 2004

Burton Rodney  
Attorney for Applicant  
Reg. No. 22,076



# INFORMATION DISCLOSURE CITATION

(Use several sheets if necessary)

ATTY. D. T. NO.  
LA0046a CIP-1  
APPLICATION NO.  
09/460,920  
APPLICANT  
Beth Anne Piper  
FILING DATE  
DECEMBER 14, 1999

Group  
1614



## U.S. PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUBCLASS	FILING DATE
	AA						
	AB						
	AC						
	AD						
	AE						
	AF						
	AG						
	AH						
	AI						
	AJ						
	AK						
	AL						

## FOREIGN PATENT DOCUMENTS

		DOCUMENT NUMBER	DATE	OFFICE	CLASS	SUBCLASS	TRANSLATION	
							YES	NO
	AM						<input type="checkbox"/>	<input type="checkbox"/>
	AN						<input type="checkbox"/>	<input type="checkbox"/>
	AO						<input type="checkbox"/>	<input type="checkbox"/>
	AP						<input type="checkbox"/>	<input type="checkbox"/>
	AQ						<input type="checkbox"/>	<input type="checkbox"/>

## OTHER DOCUMENTS (Including Author, Title, Date, Pertinent pages, Etc.)

	AR	Moses, R. et al., "Effect of replaglinide addition to metformin monotherapy on glycemic control in patients with type 2 diabetes", Diabetes Care (1999) Vol. 22(1), pages 119-124.
	AS	
	AT	

EXAMINER

DATE CONSIDERED

\*EXAMINER: Initial of reference considered, whether or not citation is in conformance with MPEP 609: Draw a line through citation if not in conformance and not considered. Include a copy of this form with the next communication to applicant.



UNITED STATES PATENT AND TRADEMARK OFFICE

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LA0046A  
US-CPA

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/460,920	12/14/1999	BETH ANNE PIPER	LA0046A /	3115
23914 7590 10/01/2004				
STEPHEN B. DAVIS BRISTOL-MYERS SQUIBB COMPANY PATENT DEPARTMENT P O BOX 4000 PRINCETON, NJ 08543-4000				
EXAMINER COOK, REBECCA				
ART UNIT PAPER NUMBER				
1614				
DATE MAILED: 10/01/2004				



Please find below and/or attached an Office communication concerning this application or proceeding.

**RECEIVED**  
**BMS PATENT LAW**

OCT 04 2004

Docketed Item 11/1/2004  
Due Date \_\_\_\_\_  
Attorney Rodney

→ Brenda Gray  
571-272-0528

Margaret Stearns { 571-272-0553

Rebecca Cook  
571-272-0547

EXHIBIT E

PTO-90C (Rev. 10/03)

Ex. Rebecca Cook's Tel Ns



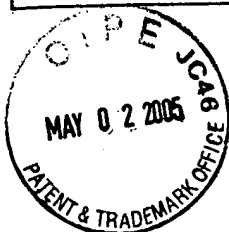
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www.uspto.gov

APPLICATION NUMBER

FILING DATE

FIRST NAMED APPLICANT

ATTY. DOCKET NO./TITLE



DATE MAILED:

### NOTICE OF IMPROPER REQUEST FOR CONTINUED EXAMINATION (RCE)

The request for continued examination (RCE) under 37 CFR 1.114 filed on May 12, 2003 is improper for reason(s) indicated below:

- ☐ 1. Continued examination under 37 CFR 1.114 does not apply to an application for a design patent. Applicant may wish to consider filing a continuing application under 37 CFR 1.53(b) or a CPA under 37 CFR 1.53(d). An RCE cannot be treated as a CPA.
- ☐ 2. Continued examination under 37 CFR 1.114 does not apply to an application that was filed before June 8, 1995. Applicant may wish to consider filing a continuing application under 37 CFR 1.53(b).
- ☐ 3. Continued examination under 37 CFR 1.114 does not apply to an application unless prosecution in the application is closed. If the RCE was accompanied by a reply to a non-final Office action, the reply will be entered and considered under 37 CFR 1.111. If the RCE was not accompanied by a reply, the time period set forth in the last Office action continues to run from the mailing date of that action.
- ☐ 4. The request was not filed before payment of the issue fee, and no petition under 37 CFR 1.313 was granted. If this application has not yet issued as a patent, applicant may wish to consider filing either a petition under 37 CFR 1.313 to withdraw this application from issue, or a continuing application under 37 CFR 1.53(b).
- ☐ 5. The request was not filed before abandonment of the application. The application was abandoned, or proceedings terminated on \_\_\_\_\_. Applicant may wish to consider filing a petition under 37 CFR 1.137 to revive this abandoned application.
- ☒ 6. The request was not accompanied by the fee set forth in 37 CFR 1.17(e) as required by 37 CFR 1.114. Since the application is not under appeal, the time period set forth in the final Office action or notice of allowance continues to run from the mailing date of that action or notice.
- ☒ 7. The request was not accompanied by a submission as required by 37 CFR 1.114. Since the application is not under appeal, the time period set forth in the final Office action or notice of allowance continues to run from the mailing date of that action or notice.

**Note:** A continued prosecution application (CPA) under 37 CFR 1.53(d) cannot be filed in a utility or plant application. A CPA filed in a utility or plant application that has a filing date on or after June 8, 1995 will be treated as an RCE under 37 CFR 1.114. The request for a CPA in the instant application, however, has been treated as an improper RCE for the reason(s) indicated above.

**A copy of this notice MUST be returned with any reply.**

Direct the reply and any questions concerning this notice to:

Patterson, Technology Center 1600  
571-272-6544  
(703) 30

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